



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/007,109	11/19/2001	Braj Bhushan Lohray	U 013701-9	3537

140 7590 11/19/2003

LADAS & PARRY
26 WEST 61ST STREET
NEW YORK, NY 10023

EXAMINER

KIFLE, BRUCK

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 11/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/007,109

Applicant(s)

LOHRAY ET AL.

Examiner

Bruck Kifle, Ph.D.

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3. 6) ☐ Other: _____

Art Unit: 1624

Election/Restrictions

Applicant's election of a compound of formula (IIIe) where R^1 , R^2 , R^3 and R^4 represent hydrogen, X represents oxygen, n represents 2 in Paper No. 10 is acknowledged. Applicants response is incomplete because A and L^1 have not been elected. Applicants need to elect a species.

The search was conducted to embrace compounds wherein X represents oxygen and A is a benzene ring.

Applicants are also advised of MPEP 803.02 Restriction - Markush Claims [R - 2], fourth paragraph, where is stated;

“As an example, in the case of an application with a Markush - type claim drawn to the compound C - R, wherein R is a radical selected from the group consisting of A, B, C, D, and E, the examiner may require a provisional election of a single species, CA, CB, CC, CD, or CE. The Markush - type claim would then be examined fully with respect to the elected species and any species considered to be clearly unpatentable over the elected species. If on examination the elected species is found to be anticipated or rendered obvious by prior art, the Markush - type claim and claims to the elected species shall be rejected, and claims to the non - elected species would be held withdrawn from further consideration. As in the prevailing practice, **a second action on the rejected claims would be made final.**” (emphasis added).

Claim Rejections - 35 USC § 112

Claims 34 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 1624

- i) It is unclear what the “derivatives” or “analogs” of the compound of claim 34 are. The metes and bounds are not clear. The structural formula along with the definitions of the variables define what is claimed. What else is intended? See also the phrases “carboxylic acid or its derivatives” and “sulfonic acid or its derivatives” which are indefinite.
- ii) The term “substituted” without saying which substituents are intended is indefinite. One skilled in the art cannot say which substituents are permitted and which ones are not.
- iii) The term “cycloalkyl” is indefinite because it is not known how many atoms make up the ring and what kind of a ring is intended (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.).
- iv) The term “heteroaryl” is indefinite because it is not known how many atoms are present, how many and what kind of heteroatoms are involved, what size ring is intended and how many rings are present.
- v) The term “heterocyclic” is indefinite because it is not known how many atoms make up the ring, which atoms are present and what kind of a ring (monocyclic, bicyclic, spiro, fused, bridged, saturated, etc.) is intended.
- vi) The leaving group L^1 is not defined. Applicants need to say what the intended scope is. The specification at page 20 exemplifies some groups. Applicants need to insert this definition into the claim because such limitation cannot be read into the claim. See *In re Priest* (199 USPQ 11).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

Art Unit: 1624

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 34 is rejected under 35 U.S.C. 102(b) as being anticipated by Andersen et al. (WO 95/18793). The claim reads on 10-(3-chloropropyl)-10H-Phenoxazine (see page 25, line 17).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bruck Kifle, Ph.D. whose telephone number is 703-305-4484. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 703-308-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



Bruck Kifle, Ph.D.
Primary Examiner
Art Unit 1624

BK
November 14, 2003